

### Remarks

These Remarks are in reply to the Office action mailed on August 28, 2006. Claims 1-32 are presented herewith for consideration.

#### Rejection Under 35 USC §103(a)

Claims 1-32 are rejected under 35 USC §103(a) as being anticipated by Rogers (U.S. Publication No. 2005/0137015 A1) in view of Stuart (U.S. Publication No. 2004/0121295 A1) and further in view of Cook (U.S. Publication No. 2002/0168621 A1).

In response to the prior Office action, applicant set forth the declarations of Patricia Franklin, Kenneth Eklund and Fred Borchardt under 37 C.F.R. §1.131. Each of the declarations was submitted to set forth facts establishing a date of invention prior to the priority date of August 19, 2003. Rogers has a priority date of August 19, 2003. Accordingly, the Declarations were submitted in order to overcome Rogers as a reference.

In the current Office action, the Examiner has alleged that the filed declarations were ineffective to remove Rogers as a reference as applicant did not point out or map to specific claim limitations. A map to the specific claim limitations is set forth below.

#### I. Independent Claim 1

Claim 1 recites:

An e-learning system allowing a user of the system to obtain mentoring and to collaborate with others over a computer system, the e-learning system comprising:

a simulation presented to the user over the computer system, the simulation including a plurality of characters, the user role-playing one of the characters;

a mentoring opportunity in which the user is capable of receiving mentoring over the computer system based on the user's actions in the simulation; and

a collaboration opportunity in which the user is capable of collaborating with others over the computer system.

A. Preamble of Claim 1

Claim 1 recites in the preamble:

An e-learning system allowing a user of the system to obtain mentoring and to collaborate with others over a computer system...

The filed declarations show that these features existed prior to August 19, 2003. In particular, Ms. Franklin's declaration shows these features to have existed prior to August 19, 2003 at least at the following paragraphs:

| <u>Para.</u> | <u>Declaration Support</u>   |
|--------------|--|
| 7            | "long before August 19, 2003, I began to develop a multimedia learning platform using historical figures as the MetaMentors... During that period, I realized that the most meaningful way for them to be relevant for learners would be through presenting learners with modern day, multimedia scenarios that mapped to the challenges that Meta Mentors experienced in their lives."  |
| 9            | "I thought at that time to use actual results for an individual in the multimedia learning platform, by having characters in the multimedia platform conforming to the various personality types. The characters would be portrayed in real-life scenarios that the learner would be presented with in their day-to-day work. This was an extremely important concept to me because all of the training and e-learning platforms I was aware of to that date were very stiff and boring. These existing platforms did not engage the learners with characters or scenarios that the learner could actually relate to. I wanted to develop a platform that would be personal to the users." |
| 15           | "My idea was to provide feedback, assistance and mentoring to a learner based on the choices he/she made in the simulation. I thought to do this in two ways. The first was through the concept of a MetaMentor. The second was through a virtual world which was full of useful resources the learner could avail themselves of."   |

Mr. Eklund's declaration shows the above-described claim features to have existed prior to August 19, 2003 at least at the following paragraphs:

| <u>Para.</u> | <u>Declaration Support</u>  |
|--------------|---|
| 4            | "Some time before August 19, 2003, Ms. Franklin asked me to work on putting together a prototype of a multimedia e-learning platform. At that time, I began working on the script for the e-learning platform with the assistance of Ms. Franklin and Lucy Carter." |

|   |   |
|---|---|
| 9 | “The idea of using live, synchronous interaction and stored, asynchronous events to provide feedback, assistance and mentoring was a concept I discussed with Ms. Franklin before August 19, 2003. The script which was written that incorporated these concepts was also conceived of before August 19, 2003.” |
|---|---|

Mr. Borchardt’s declaration shows the above-described claim features to have existed prior to August 19, 2003 at least at the following paragraphs:

| <u>Para.</u> | <u>Declaration Support</u>  |
|--------------|---|
| 4            | “Patricia Franklin and I met in January, 2002... I visited Ms. Franklin’s home, where she began to fill me in on her online e-learning platform, referred to as LIFE™, and the gist of the script already undertaken by Ken Eklund. We agreed on my role as Creative & Technical Producer. At that time, I began working on the software for implementing the e-learning platform with others including Bruce Eng.” |
| 11           | “The idea of using live, synchronous interaction and stored, asynchronous events to provide feedback, assistance and mentoring was a concept I discussed with Ms. Franklin before August 19, 2003. The software I helped author that implemented these concepts in the e-learning platform was also created before August 19, 2003.”  |

Each of the facts set forth above and in the attached declarations shows that the features recited in the preamble relating to “an e-learning system allowing a user of the system to obtain mentoring and to collaborate with others over a computer system” occurred prior to August 19, 2003.

B. First Clause of Claim 1

Claim 1 recites in a first clause:

a simulation presented to the user over the computer system, the simulation including a plurality of characters, the user role-playing one of the characters.

The filed declarations show that this feature existed prior to August 19, 2003. In particular, Ms. Franklin’s declaration shows these features to have existed prior to August 19, 2003 at least at the following paragraphs:

| <u>Para.</u> | <u>Declaration Support</u>  |
|--------------|---|
| 11           | "One important aspect of the platform was to present a multimedia simulated event to a user via their computer display. The multimedia simulated event would include characters in conflict, where the learner would role-play one of the characters. The learner would then interact with the platform through computer input devices (keyboard, mouse) in an attempt to resolve the conflict in the multimedia simulation as best they could by making appropriate selections from decision-time menus."  |
| 14           | "Prior to August of 2003, working from Ken Eklund's original script, the programming team assembled the video and audio into scenarios in which the user would role play one of the characters in the simulation. The role-played character would interact with others in the simulation and the role-played character would be presented with a conflict. The learner would then be presented with, for example, 4 or 5 on-screen options of how to deal with the conflict. The user would choose one of the options using, for example, a mouse or keyboard. Once the user's choice was made, the consequences of that selection were played on the screen for the user." |

Mr. Eklund's declaration shows the above-described claim features to have existed prior to August 19, 2003 at least at the following paragraphs:

| <u>Para.</u> | <u>Declaration Support</u>   |
|--------------|--|
| 5            | "In the script we came up with, a user would role play a character in a computer simulation. The role-played character would interact with others in the simulation and the role-played character would be presented with a conflict. The learner would then be presented with, for example, 4 or 5 on-screen options of how to deal with the conflict. The user would choose one of the options using, for example, a mouse or keyboard. Once the user's choice was made, the consequences of that selection were played on the screen for the user." |

Mr. Borchardt's declaration shows the above-described claim features to have existed prior to August 19, 2003 at least at the following paragraphs:

| <u>Para.</u> | <u>Declaration Support</u>   |
|--------------|--|
| 5            | "In the software, a user would role play one of a character in a computer simulation. The role-played character would interact with others in the simulation and the role-played character would be presented with a conflict. The learner would then be presented with, for example, 4 or 5 on-screen options of how to deal with the conflict. The user would choose one of the options using, for example, a mouse or keyboard. Once the user's |

|  |  |
|--|--|
|  | choice was made, the consequences of that selection were played on the screen for the user.” |
|--|--|

The Each of the facts set forth above and in the attached declarations shows that the features recited in claim 1 relating to “a simulation presented to the user over the computer system, the simulation including a plurality of characters, the user role-playing one of the characters” were conceived of prior to August 19, 2003.

C. Second Clause of Claim 1

Claim 1 recites in a second clause:

a mentoring opportunity in which the user is capable of receiving mentoring over the computer system based on the user’s actions in the simulation.

The filed declarations show that this feature existed prior to August 19, 2003. In particular, Ms. Franklin’s declaration shows these features to have existed prior to August 19, 2003 at least at the following paragraphs:

| <u>Para.</u> | <u>Declaration Support</u>   |
|--------------|--|
| 7            | “still long before August 19, 2003, I began to develop a multimedia learning platform using historical figures as the MetaMentors... During that period, I realized that the most meaningful way for them to be relevant for learners would be through presenting learners with modern-day, multimedia scenarios that mapped to the challenges that Meta Mentors experienced in their lives.”  |
| 15           | “My idea was to provide feedback, assistance and mentoring to a learner based on the choices he/she made in the simulation. I thought to do this in two ways. The first was through the concept of a MetaMentor. The second was through a virtual world which was full of useful resources the learner could avail themselves of.”   |
| 16           | “With respect to the MetaMentor, as discussed above, I felt that sharing the experiences of famous historical figures, <i>i.e.</i> , the Meta Mentors, would be a very effective mentoring tool. This was true for at least two reasons. First, the MetaMentors were famous, memorable, capable and respected figures from history. Second, the real-life experiences the MetaMentors would share with the learners would be related to the experience the user just had in the simulation. I realized that the parallels between the experience shared by the MetaMentor and the experience of the learner in the simulation would make the advice offered by the MetaMentor a personal and meaningful experience.” |

|    |   |
|----|---|
| 17 | "The MetaMentors would be presented to the learner over the display when the learner needed assistance, or where his/her choice indicated that he/she needed advice. The software platform would present the learner with a multimedia clip (video or a series of still images) showing the MetaMentor and/or narrated by someone in the voice of the MetaMentor, and illustrating the experience the Meta Mentor shares with the learner." |
|----|---|

Mr. Eklund's declaration shows the above-described claim features to have existed prior to August 19, 2003 at least at the following paragraphs:

| <u>Para.</u> | <u>Declaration Support</u>   |
|--------------|--|
| 6            | "Ms. Franklin's idea that was incorporated into the script was to provide feedback, assistance and mentoring to a learner based on the choices he/she made in the simulation. Ms. Franklin's idea of how to do this was twofold. The first was through the concept of a MetaMentor. The second was through a virtual world which was full of useful resources the learner could avail themselves of. Ms. Franklin discussed both of these concepts with me prior to August of 2003." |

Mr. Borchardt's declaration shows the above-described claim features to have existed prior to August 19, 2003 at least at the following paragraphs:

| <u>Para.</u> | <u>Declaration Support</u>   |
|--------------|--|
| 6            | "Ms. Franklin's idea that was incorporated into the software was to provide feedback, assistance and mentoring to a learner based on the choices he/she made in the simulation. Ms. Franklin's idea of how to do this was twofold. The first was through the concept of a MetaMentor. The second was through a virtual world which was full of useful resources the learner could avail themselves of. Ms. Franklin discussed both of these concepts with me prior to August of 2003."   |
| 5            | "Prior to August of 2003, we incorporated the concept of MetaMentors into the software for the e-learning platform. The MetaMentors were presented to the learner over the display when the learner needed assistance, or where his/her choice indicated that he/she needed advice. In the software platform that I helped write, the learner was presented with a multimedia clip (video or a series of still images) showing the MetaMentor and/or narrated by someone in the voice of the MetaMentor, and illustrating the experience the Meta Mentor shares with the learner." |

Each of the facts set forth above and in the attached declarations shows that the features recited in claim 1 relating to “a mentoring opportunity in which the user is capable of receiving mentoring over the computer system based on the user’s actions in the simulation” were conceived of prior to August 19, 2003.

D. Final Clause of Claim 1

Claim 1 recites in a final clause:

a collaboration opportunity in which the user is capable of collaborating with others over the computer system.

The filed declarations show that this feature existed prior to August 19, 2003. In particular, Ms. Franklin’s declaration shows these features to have existed prior to August 19, 2003 at least at the following paragraphs:

| <u>Para.</u> | <u>Declaration Support</u>   |
|--------------|--|
| 14           | “when the learner entered the 24/7 online component, also known as “Level Two” or the “Virtual World”, the learner required an identity and this meant that the learner would have a symbol, avatar, emoticon, photo or text name to let others know who he or she was in this online community of best practice. In this case, the use of an avatar was not for a role-playing game, but rather as a means of identification of real people within an online community.”  |
| 19           | “The synchronous resources were other people with whom the learner could communicate in real time and who could provide advice and mentoring to the learner. There were several ways I thought to do this, including for example using instant messaging where two people could communicate with each other over an Internet connection. These other people could be represented in the virtual world and displayed to the learner as, for example, avatars. The learner would see an avatar in the virtual world. By selecting that avatar, a real time communications link could be established between the learner and the person whose avatar was selected. The learner could then converse with the selected person to learn more about how the learner could have handled the simulation better. The avatar or representation of the expert could also be static and the learner could simply click on their representation and a database of their knowledge would become available.” |

Mr. Eklund’s declaration shows the above-described claim features to have existed prior to August 19, 2003 at least at the following paragraphs:

| <u>Para.</u> | <u>Declaration Support</u>   |
|--------------|--|
| 6            | "Ms. Franklin's idea that was incorporated into the script was to provide feedback, assistance and mentoring to a learner based on the choices he/she made in the simulation. Ms. Franklin's idea of how to do this was twofold. The first was through the concept of a MetaMentor. The second was through a virtual world which was full of useful resources the learner could avail themselves of. Ms. Franklin discussed both of these concepts with me prior to August of 2003." |

Mr. Borchardt's declaration shows the above-described claim features to have existed prior to August 19, 2003 at least at the following paragraphs:

| <u>Para.</u> | <u>Declaration Support</u>   |
|--------------|--|
| 6            | "Ms. Franklin's idea that was incorporated into the software was to provide feedback, assistance and mentoring to a learner based on the choices he/she made in the simulation. Ms. Franklin's idea of how to do this was twofold. The first was through the concept of a MetaMentor. The second was through a virtual world which was full of useful resources the learner could avail themselves of. Ms. Franklin discussed both of these concepts with me prior to August of 2003."   |
| 9            | "The synchronous resources were other people with whom the learner could communicate in real time and who could provide advice and mentoring to the learner. This was implemented in the software platform several ways, including for example using instant messaging where two people could communicate with each other over an Internet connection. These other people were represented in the virtual world and displayed to the learner as, for example, avatars. The learner saw an avatar in the virtual world. By selecting that avatar, a real time communications link was established between the learner and the person whose avatar was selected. The learner could then converse with the selected person to learn more about how the learner could have handled the simulation better." |

Each of the facts set forth above and in the attached declarations shows that the features recited in claim 1 relating to "a collaboration opportunity in which the user is capable of collaborating with others over the computer system" were conceived of prior to August 19, 2003.

Applicant has mapped above from the 1.131 declarations to each of the specific claim limitations in claim 1 showing how each of the specific claim limitations of claim 1 was conceived of prior to August 19, 2003.



II. Independent Claim 11

Claim 11 recites:

An e-learning system allowing a user of the system to obtain mentoring over a computer system, the e-learning system comprising:

a simulation presented to the user over the computer system, the simulation including a plurality of characters, the user role-playing one of the characters; and

a mentoring opportunity in which the user is capable of receiving mentoring over the computer system based on the user's actions in the simulation, the mentoring coming at least in part from a MetaMentor, the MetaMentor being stored information presented to the user over the computer system representing a famous person, the MetaMentor further having associated stored knowledge, experience and information from the person represented by the MetaMentor.

As discussed above, each of these limitations is shown to have existed prior to August 19, 2003 in the declarations of Patricia Franklin, Kenneth Eklund and Fred Borchardt filed under 37 C.F.R. §1.131. The preamble of claim 11 is shown in the declarations as set forth in Section (I)(A) above. The first clause of claim 11 is shown in the declarations as set forth in Section (I)(B) above. The second clause of claim 11 is shown in the declarations as set forth in Section (I)(C) above.

Applicant has accordingly mapped from the 1.131 declarations to each of the specific claim limitations of claim 11 showing how each of the specific claim limitations was conceived of prior to August 19, 2003.

III. Independent Claim 18

Claim 18 recites:

An e-learning system allowing a user of the system to obtain mentoring over a computer system, the e-learning system comprising:

a self-assessment in which the user is accessed through a series of questions presented to the user;

a simulation presented to the user over the computer system, the simulation including a plurality of characters, the user role-playing one of the characters; and

a mentoring opportunity in which the user is capable of receiving mentoring over the computer system based on the user's actions in the simulation, the mentoring coming at least in part from stored information;

the simulation, the characters and/or the stored information that is presented to the user being at least in part dictated by the self-assessment or an assessment of some kind submitted on behalf of the user.

Each of these limitations is shown to have existed prior to August 19, 2003 in the declarations of Patricia Franklin, Kenneth Eklund and Fred Borchardt filed under 37 C.F.R. §1.131. The preamble of claim 18 is shown in the declarations as set forth in Section (I)(A) above. The second clause of claim 18 (*i.e.*, relating to the simulation) is shown in the declarations as set forth in Section (I)(B) above. The third clause of claim 18 is shown in the declarations as set forth in Section (I)(C) above.

With respect to the first and last clauses of claim 18 relating to self-assessment and dictating the simulation, characters and/or stored information based on the assessment, this feature is discussed in the declaration of Patricia Franklin at least at paragraph 9:

Before August 19, 2003, I met with Sherry Prescott at the Mountain View, California headquarters of CPP, Inc. (formerly Consulting Psychologists Press). Sherry Prescott was the head of Marketing at CPP which is the worldwide distributor of the Myers-Briggs Personality Type Indicator. It was around that time that I began to realize that the real application for this was going to be in the corporate setting. Many people in corporations are regularly typed by the Myers-Briggs Personality Type Indicator. I thought at that time to use actual results for an individual in the multimedia learning platform, by having characters in the multimedia platform conforming to the various personality types. The characters would be portrayed in real-life scenarios that the learner would be presented with in their day-to-day work. This was an extremely important concept to me because all of the training and e-learning platforms I was aware of to that date were very stiff and boring. These existing platforms did not engage the learners with characters or scenarios that the learner could actually relate to. I wanted to develop a platform that would be personal to the users.

Applicant has accordingly mapped from the 1.131 declarations to each of the specific claim limitations of claim 18 showing how each of the specific claim limitations was conceived of prior to August 19, 2003.

IV. Independent Claim 21

Claim 21 recites:

An e-learning system allowing a user of the system to obtain mentoring and to collaborate with others over a computer system and a network of which the computer system is part, the e-learning system comprising:

a simulation presented to the user over the computer system, the simulation including a plurality of characters, the user role-playing one of the characters; and

a mentoring and collaboration portal through which the user may access knowledge available from other sources over the network bearing on the user's actions in the simulation

Each of these limitations is shown to have existed prior to August 19, 2003 in the declarations of Patricia Franklin, Kenneth Eklund and Fred Borchardt filed under 37 C.F.R. §1.131. The preamble of claim 21 is shown in the declarations as set forth in Section (I)(A) above. The first clause of claim 21 is shown in the declarations as set forth in Section (I)(B) above. The second clause of claim 18 is shown in the declarations as set forth in Section (I)(C) above. The second clause of claim 18 is also shown in the declaration of Patricia Franklin at least at paragraph 18:

The second way I thought of to provide feedback, assistance and mentoring to a learner based on the choices he/she made in the simulation was through a simulated portal presented to the user on his or her computer display which, when selected by the learner, would bring him or her to a virtual world full of resources relating to the experience the learner had in the simulation. These resources were both synchronous and asynchronous resources.

Based on the above, it is respectfully submitted that the declarations filed under 37 C.F.R. §1.131 are sufficient to establish conception of the claimed invention prior to August 19, 2003. It is therefore respectfully requested that the Rogers reference is not prior art to the present invention, and it is respectfully requested that Rogers be removed as a basis for rejecting the present claims. Applicant

has set forth the express support in the declarations for each of the limitations in the independent claims, and as such, Rogers should be removed as a rejection of the independent claims. The declarations also support the limitations of the dependent claims, and accordingly, Rogers should also be removed as a basis for rejection of those claims as well.

V. Examiner's Allegation of Public Disclosure of the Invention

At page 17 of the Office action, at paragraph 6, the Examiner stated that because one paragraph of Patricia Franklin's declaration referred to "many years prior to August 19, 2003," that applicant has conceded that the invention is barred under 35 U.S.C. §102(b). The Examiner stated:

Henceforth, the inventor Patricia Franklin concedes that more than one year prior to August 19, 2003, she disclosed the merits of the invention to a member of the public. Therefore, Patricia Franklin has voluntarily lost her right to patent by making the merits of the application public knowledge.

Applicant respectfully submits that this is both a mischaracterization of Mr. Franklin's declaration and incorrect statement of the law of anticipation under 35 U.S.C. §102(b).

The statement referred to by the Examiner, taken in its full context, is as follows:

Many years prior to August 19, 2003, I attended a conference in San Francisco to commemorate the 100<sup>th</sup> anniversary of the invention of the radio by Guglielmo Marconi. While there, I met Enrico Garaci, the head of the National Science Foundation of Italy. During our discussion, I was talking to him about the use of multimedia and the ability that it would afford a learner to be able to connect with some of the greatest people who have ever lived, such as Leonardo De Vinci, Michelangelo and Galileo.

The invention is defined by the claims of the application. A discussion regarding the use of multimedia and the ability of a learner to be able to connect with historical figures, while relating to a part of the invention, is not the invention. Ms. Franklin did not concede that the invention, or the merits of the invention, were publicly disclosed more than one year prior to filing the instant patent application.

Based on the above amendments and these remarks, reconsideration of Claims 1-32 is respectfully requested.

The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, February 28, 2007.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: February 28, 2007

By: /Brian I. Marcus/  
Brian I. Marcus  
Reg. No. 34,511

VIERRA MAGEN MARCUS & DENIRO LLP  
575 Market Street, Suite 2500  
San Francisco, CA 94105  
Telephone: (415) 369-9660  
Facsimile: (415) 369-9665